

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The changes made to claim 43 have been reviewed and accepted; therefore, the rejection under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 43 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either an asserted utility or a well established utility.

This printed matter still does not have a practical application. That is, it does not have a physical transformation or a useful, concrete, and tangible result. In addition, the invention does not fall under one of the statutory categories of invention. Please see MPEP 706.03(a)(A).

Claim 43 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Response to Arguments

4. Applicant's arguments filed 3/7/2008 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance:

(A) "the instruction is a machine-executable and configured to operate an electronic device when executed...Herzig simply neither describe nor suggest this subject matter of claim 43...in page 13...the telephone number of Herzig is at best data used by an instruction to perform a telephone call, but is not an instruction to place a telephone call...it cannot be said that a telephone number is an instruction..."

Regarding argument (A), the examiner would like to explain where according to the applicant specifications, an example of an instruction is "make a phone call", where it is precisely what Herzing's invention is doing, as known in the art, a telephone number is required to make a phone call, where stored instructions usually are relayed by a controller, and executed either by software or hardware. E.g., see figure 10, where the "scanning", "processing" and "dialing" steps are instructions to be executed, to place a telephone call. The instruction are derived from identifying at least a telephone number.

(B) "...the prior art of record does not each and every limitation of claim 1..."

Regarding argument (B), the examiner would like to indicate where given the broadness of the claim, the prior art of record reads on the limitations, where the limitations do not show a flow where one can read them as elements linked to each other. Instead, some of the elements can be read as disjointed elements that perform some functions that might or might not be linked to the purpose of the invention.

Regarding the emphasized limitation that reads, "data output means operable to output image data and associated metadata for generating a printed image which incorporates the metadata in a form readable by the electronic device", the examiner would like to indicate where at least Schultheis teaches where an image is printed along with additional information (additional data in text form) related to the image, where the additional data in text form corresponds to metadata.

(C) Silverbrook says nothing about 'data output means operable to output image data and associated metadata'...Schultheis is not seen to remedy this deficiency of Silverbrook."

Regarding argument (C), the examiner would like direct the applicant to argument (B) where this limitation is addressed.

5. Applicant's arguments, see amendment, filed 6/13/2007, with respect to the rejection(s) of claim(s) under Claim Rejections - 35 USC § 102 (e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Silverbrook and Schultheis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Herzig et al. (Herzig, US Patent No.: 6,594,503 B1).

Regarding claim 43, Herzig teaches of a document bearing a printed image and incorporating machine readable metadata associated with the image (column 3, lines 31-42, where the claim does not indicate when/how the additional data, metadata, is incorporated. Column 2, lines 14-40, where the printed image (e.g., a "name") is scanned and additional data, metadata, is added, e.g., "telephone number". In addition, the metadata can be machine readable (where the machine is a scanner)), the metadata comprising at least a machine-readable instruction configured to operate an electronic device when executed (column 2, lines 20-44, where by reading the telephone or fax number, the electronic device operates, e.g., makes a call).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-12, 14-17, 22-23, 26-37 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook, Kia (Silverbrook, US Pub. No.: 2002/0,140,993 A1) and further in view of Schultheis, Joerg-Peter (Schultheis, DE010158358351A1).

Regarding claim 1, Herzig teaches of an electronic device (figure 2) comprising: data reading means operable to read metadata carried by an image carrier which carries a printed image (column 2, lines 21-24, where paper images can be carried in a folder); interpretation means operable to interpret the metadata to identify an instruction for operation of the device (column 2, lines 14-17, where the instruction is to dial a number); and execution means operable to cause the device to execute an instruction identified by the interpretation means (column 5, lines 46-47, where the "code representation is sent to the network" to request a call set up); and image system comprising (column 2, lines 21-29, where a system can comprise several elements that perform a function(s)) image means operable to receive data representing an image (columns 2 and 4, lines 21-25 and 11-16, where OCR/camera receive data representing an image); metadata means operable to generate metadata able to be interpreted to identify an instruction for an electronic device (column 2, lines 14-40, where the image received is a "name" and the metadata is the additional data collected from a look-up table, "telephone number" and the instruction is to dial a number), and to associate the metadata with the image data (column 2, lines 14-40, where a "telephone number" is

associated with a "name"), where the device is a hand portable electronic device (column 2, lines 11-13).

Herzig teaches of printing the image, however, it is done in a separate device. Therefore, Herzig does not specifically teach of comprising printer means operable to receive data representing an image, and associated metadata, and to generate a printed image.

In art concerning a handheld mobile telephone with integral printer, Silverbrook teaches of comprising printer means operable to receive data representing an image, and associated metadata, and to generate a printed image, which incorporates the metadata (paragraphs 4 and 44 and claim 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's printed data with Silverbrook's printer in order to obtain a hard copy of captured images.

Herzig and Silverbrook do not specifically teach where the printed image incorporates the metadata.

In related art concerning a digital photographic and scanner camera with internal bar code scanner that can acquire additional data in text form as well as the digital photographs optically acquired by the camera, Schultheis teaches where the printed image incorporates the metadata (Abstract, where the additional text data, metadata, is added to the image).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's and Silverbrook's combined scanner/printer

with Schultheis's addition of text data in to image in order to obtain data related plus the photographs in a printed form.

Regarding claim 3, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the device is a multi-function portable device (column 2, lines 29-33, where in addition, the telephone can do faxes, internet; thus, multi-function).

Regarding claims 4 and 31, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 1 and 29, respectively. Herzig further teaches the device is operable as a cellular telephone (column 2, lines 12-14).

Regarding claim 5, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the execution means is operable to cause the device to initiate communication in response to an identified instruction (column 2, lines 14-17, where the instruction is to dial a number that starts the communication).

Regarding claims 6 and 29, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 1 and 28, respectively. Herzig further teaches where the interpretation means is operable, in use, to recover personal data from the metadata (column 2, lines 29-40; e.g., "name", "phone number" and "fax number").

Regarding claims 7 and 30, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 6 and 29, respectively. Herzig further teaches where the personal data recovered by the interpretation means includes at least one of a name,

Art Unit: 2618

telephone number and contact details (column 2, lines 29-40; e.g., "name", "phone number" and "fax number").

Regarding claims 8 and 28, Herzig, Silverbrook and Schultheis teach all the limitations according to claims 6 and 1, respectively. Herzig further teaches where the execution means is operable in response to an identified instruction to initiate communication with an individual identified by the personal data (column 2, lines 29-40; e.g., "name", "phone number" and "fax number"; where the call is intending to initiate communication with the individual identified by name at least).

Regarding claim 9, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 6. Herzig further teaches where the execution means is operable to add the personal data to the memory of the device, if not already contained there (column 2, lines 58-64; e.g., "memory 135").

Regarding claim 10, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the data reading means is an optical device, which responds to metadata carried in visible form by the image carrier (column 2, lines 21-24).

Regarding claim 11, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 10. Herzig further teaches where the visible metadata is carried in the form of a bar code (column 1, lines 31-34).

Regarding claim 12, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the data reading means is a non-optical device operable to detect metadata carried in machine-readable form by the

image carrier (column 1, lines 31-34; where, in addition, bar codes are read by infrared light).

Regarding claim 14, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the interpretation means is operable to retrieve an instruction contained within the metadata (column 2, lines 14-17, where the instruction is to dial a number).

Regarding claim 15, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 14. Herzig further teaches where the interpretation means interprets a retrieved instruction by reference to further stored interpretation data (column 2, lines 14-17, where the instruction is to dial a number (phone, fax, internet address, etc.) that has been retrieved from storage and where the software is programmed to automatically dial the retrieved number).

Regarding claim 16, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 15. Herzig further teaches where the interpretation means is operable to receive metadata from the data reading means, in the form of an identifier, and uses the further stored interpretation data to recover an instruction identified by the identifier (column 2, lines 14-17, where the instruction is to dial a number (phone, fax, internet address, etc.) that has been retrieved from storage and where the software is programmed to automatically dial the retrieved number).

Regarding claim 17, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 15. Herzig further teaches where the further stored interpretation data is stored remotely, the interpretation means being operable to communicate with

the remote location to enable the interpretation means to use the further stored interpretation data (column 3, lines 20-27, "external character recognition processor").

Regarding claim 22, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable in response to a user input to generate metadata (column 3, lines 9-18, where the user's input is scanning the pictures, code, text, etc.).

Regarding claim 23, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable to retrieve stored data for incorporation into the metadata (column 3, lines 21-27, where the stored data can be a telephone number, address, etc.).

Regarding claim 26, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable to analyze a represented image to identify a subject therein, and to provide data representative of the subject, for incorporation into the metadata (column 2, lines 33-40, e.g., "name" corresponding to a subject).

Regarding claim 27, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1. Herzig further teaches where the metadata means is operable to perform a selection of stored data from a stored data set, the selection being performed in dependence on data to be incorporated into the metadata, to recover additional data for incorporation (column 3, lines 25-41).

Regarding claim 32, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1.

Silverbrook teaches of comprising printer means operable to receive data representing an image, and associated metadata, and to generate a printed image, which incorporates the metadata (paragraphs 4 and 44 and claim 16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' printed data with Silverbrook's further teachings about a printer in order to obtain a hard copy of captured images.

Schultheis further teaches where the printed image incorporates the metadata (Abstract, where the additional text data, metadata, is added to the image).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' combined scanner/printer with Schultheis's addition of text data in to image in order to obtain data related, plus the photographs in a printed form.

Regarding claim 33, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32.

Schultheis further teaches where the metadata is incorporated within the image area of the printed image (abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's and Silverbrook's combined scanner/printer with Schultheis's addition of text data in to image in order to obtain data related plus the photographs in a printed form.

Regarding claim 34, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 33. Herzig further teaches where the metadata is incorporated in encoded form (column 1, lines 31-33; e.g., "bar code format").

Regarding claim 35, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches where the metadata is incorporated in an optically readable form (column 2, lines 21-24).

Regarding claim 36, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 35. Herzig further teaches where the metadata is incorporated in the form of a bar code (column 1, lines 31-33; e.g., "bar code format").

Regarding claim 37, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches the metadata is incorporated in non-optical machine-readable form (column 1, lines 31-34; where, in addition, bar codes are read by infrared light).

Regarding claim 40, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches the metadata contains the instruction (column 2, lines 29-40; where instruction is to initiate a call).

Regarding claim 41, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches where the metadata contains sufficient information to identify the instruction by reference to further stored interpretation data (column 2, lines 29-40; where the further stored data is the phone number, internet address, fax number, etc.).

Regarding claim 42, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32. Herzig further teaches where the metadata includes an identifier usable to recover an instruction identified by the identifier (column 2, lines 26-30).

10. Claims 13 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of Schlasberg, Johan (Schlasberg, WO 99/17230).

Regarding claim 13, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 12.

Herzig, Silverbrook and Schultheis do not specifically teach where a radio frequency identification device provides the machine-readable metadata.

In related art concerning a message information system, Schlasberg teaches where the machine-readable metadata is provided by a radio frequency identification device (pages 3, 4,5, lines 7-16; lines 4-25 and 16-10, 30-34, respectively).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' electronic device with Schlasberg's RFID reader in order to directly obtain information about objects without having to be so close to them, as taught by Schlasberg.

Regarding claim 38, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 37.

Herzig, Silverbrook and Schultheis do not specifically teach where a radio frequency identification device provides the machine-readable metadata.

Schlasberg teaches where the machine-readable metadata is provided by a radio frequency identification device (pages 3, 4,5, lines 7-16; lines 4-25 and 16-10, 30-34, respectively).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's Silverbrook's and Schultheis's electronic device with Schlasberg's RFID reader in order to directly obtain information about objects without having to be so close to them, as taught by Schlasberg.

11. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of Browning, Denton R. (Browning, US Patent No.: 6,707,581 B1).

Regarding claim 24, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1.

Herzig, Silverbrook and Schultheis do not specifically teach where the metadata means is operable to incorporate data representing the conditions in which the image has been captured.

In related art concerning a remote information access system, which utilizes handheld scanner, Browning teaches where the metadata means is operable to incorporate data representing the conditions in which the image has been captured (37-47, e.g., "poor").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' electronic device

with Browning's feedback about the condition of the scanned work in order to re-scan, as taught by Browning.

Regarding claim 25, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 1.

Herzig, Silverbrook and Schultheis do not specifically teach where the metadata means is operable to incorporate at least one of time data, date data, location data and operating settings of data capture means used to capture the represented image.

Browning teaches where the metadata means is operable to incorporate at least one of time data, date data, location data and operating settings of data capture means used to capture the represented image (column 3, lines 51-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's and Schultheis' electronic device with Browning's "date and time" information in order to "facilitate later cataloguing and retrieval of scanned information", as taught by Browning.

12. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herzig in view of Silverbrook and Schultheis and further in view of Wilcock et al. (Wilcock, US Patent No.: 6,741,864 B2).

Regarding claim 39, Herzig, Silverbrook and Schultheis teach all the limitations according to claim 32.

Herzig, Silverbrook and Schultheis do not specifically teach where the metadata is written to a member, which is initially separate from the image carrier on which the image is printed, and is attachable thereto.

In related art concerning a device control apparatus and method, Wilcock teaches where the metadata is written to a member which is initially separate from the image carrier on which the image is printed, and is attachable thereto (column 11, lines 1-12, where the metadata, e.g., location, is originally, in a label separate from the picture).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Herzig's, Silverbrook's, Schultheis's combination of the device with Wilcock's labeling in order to "enable map-based cataloging of image recordings", as taught by Wilcock.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angelica Perez whose telephone number is 571-272-7885. The examiner can normally be reached on 6:00 a.m. - 1:30 p.m., Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on (571) 272-4177. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either the PAIR or Public PAIR. Status information

Art Unit: 2618

for unpublished applications is available through the Private PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Information regarding Patent Application Information Retrieval (PAIR) system can be found at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service number is 703-306-0377.

/P. M. A./

Examiner, Art Unit 2618

June 12, 2008

/Matthew D. Anderson/

Supervisory Patent Examiner, Art Unit 2618